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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/488,364 01/12/00 ELLEDGE

S 120541-1003

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EXAMINER

HM12/0315

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GIGGEN, B  
ART UNIT PAPER NUMBER

1655  
DATE MAILED:

13

03/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/488,364	ELLEDGE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Bradley L. Sisson	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 February 2001.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 7-12 and 19-35 is/are pending in the application.

4a) Of the above claim(s) 20-35 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 7-12 and 19 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

19) Notice of Informal Patent Application (PTO-152)

20) Other: \_\_\_\_\_.

**DETAILED ACTION**

*Specification*

1. The disclosure remain objected to because of the following informalities: The Sequence Listing that was provided in the response of 16 October 2000 is at conflict with the sequences identified in the claims. Specifically, the Sequence Listing has an amino acid sequence and a nucleotide sequence for SEQ ID NO:1 and SEQ ID NO:3, respectively. Claims 7 and 10 describe SEQ ID NO:1 and SEQ ID NO:3 as setting forth a nucleic acid sequence and an amino acid sequence, respectively.

2. The specification continues to contain reference to other US Patent Applications, however, the current status of same is not so indicated (e.g., page 44, line 12).

Appropriate correction is required.

Response to arguments

3. At page 3 of the response received 12 February 2001 applicant indicates that the inconsistency in numbering of the SEQ Ids a well as the current status of a cited application have been affected by an amendment. A review of the file's contents, however, fails to locate any amendment since that filed on 25 July 2000 via facsimile transmission (Paper No. 5, Amendment B). Accordingly, the aforementioned issues have not been overcome.

*Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 7-12 and 19 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as indicated above, contains a Sequence Listing that has an amino acid sequence and a nucleotide sequence for SEQ ID NO:1 and SEQ ID NO:3, respectively. SEQ ID NO:1 and SEQ ID NO:3 as set forth in the claims are directed to a nucleic acid sequence and an amino acid sequence, respectively.

Response to arguments

At page 3 of the response, last paragraph, applicant again indicates that the claims have been amended yet no amendment has been found. Accordingly, the rejection is maintained.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

- A person shall be entitled to a patent unless –
  - (f) he did not himself invent the subject matter sought to be patented.

7. Claims 7-12 and 19 remain rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. The publication of Sanchez et al., describes the combined efforts of at least 8 individuals in the isolation of what appears to be the now-claimed amino acid sequence. While the authorship of the article does contain the two identified inventors of the subject application, an additional six co-authors are also present and appear, after reading the article, to have been integrally involved in the development of the invention now claimed.

Response to argument

Applicant presents argument at pages 4-5 of the response that the six non-authors did not contribute to the now-claimed invention. This argument has not been found persuasive and especially in light of the declaration filed under Rule 37 CFR 1.132 by co-inventor Stephen J. Elledge. It is noted with particularity that the declarant is making statements not only for himself but also for another individual, Yolanda Sanchez. Declarant cannot make sworn statements on behalf of another. Further, declarant's statement that the paper was "a scientific research paper" carries no weight in removing the document. Accordingly, and in the absence of convincing evidence to the contrary, the rejection is maintained.

*Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

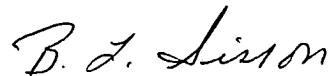
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (703) 308-3978. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Bradley L. Sisson  
Primary Examiner  
Art Unit 1655

BLS  
March 15, 2001